IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of	Group Art Unit: 2452
Lou Chauvin, et al	Examiner: Dohm Chankong
SYSTEM, METHOD AND SOFTWARE PRODUCT FOR ORDERING IMAGE PRODUCTS USING IMAGES STORED ON A DIGITAL STORAGE DEVICE FROM A PLURALITY OF ORDER TERMINALS	Confirmation No. 9965
Serial No. 10/051,340	
Filed 18 January 2002	

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APPEAL BRIEF PURSUANT TO 37 C.F.R. 41.37 and 35 U.S.C. 134

Table Of Contents

APPELLANT'S BRIEF ON APPEAL

Appellants hereby appeal to the Board of Patent Appeals and Interferences from the Examiner's Final Rejection of claims 23 and 25-29, which was contained in the Office Action mailed September 30, 2009.

A timely Notice of Appeal was filed, February 1, 2010, which was received in the USPTO on February 1, 2010.

Real Party In Interest

The Eastman Kodak Company is the real party in interest.

Related Appeals And Interferences

No appeals or interferences are known which will directly affect or be directly affected by or have bearing on the Board's decision in this appeal.

Status Of The Claims

Claims 23, 25-29, 34, 37-41 and 45 are pending in the application. Claims 1-22, 24, 30-33, 35, 36 and 42-44 have been canceled. Claims 23 and 25-29 are being appealed.

Appendix I provides a clean, double spaced copy of all the claims involved.

Status Of Amendments

Subsequent to final rejection, no amendment has been filed.

Summary of Claimed Subject Matter

With respect to independent claim 23, the claimed invention is directed to a computer implemented method comprising the steps of providing a network service on a network, such as depicted in FIG. 1, wherein a plurality of service providers 15, 18, 20, user (customer) order terminals 28, 30, 32, and service manager server 12 are connected to a network 14 over which the users can select products and services offered by the service providers (see FIGS. 6A-6D) for the user's digital images. FIG. 2 illustrates some of the internal components of the network nodes shown in FIG. 1. This network configuration is explained at least at page 6, lines 10-25 and at page 7,

lines 13-21.

A user is provided access to the network service providers by using order terminals 28, 30, 32, connected to the network 14, to communicate to the various service providers 16, 18, etc., via server 12, to order products and services such as illustrated in FIGS. 6A-6D. The order terminals are each associated with one of a plurality of business entities. An example set of such associations is illustrated at the top of FIG. 3. These features are also described at least at page 8, line 22 through page 9, line 4; page 13, lines 3-30; and at page 28, lines 23-30 which describes a portion of FIG. 9.

The user who wishes to take advantage of the features of the present invention can input his or her digital image into the order terminal by coupling a portable digital storage device, such as a CD or a camera memory card that has the digital image stored thereon, to the order terminal. This is illustrated in FIG. 7 with storage devices 191 or 195 being coupled to order terminals at various business entities 181, 183, 185, etc. The storage device is associated with a service provider identified by a code that is stored on the storage device and which is electronically read by the order terminal when the user couples the storage device thereto. These features are described at least at page 29, lines 1-10 and at page 30 line 13 through page 31 line 9.

Hence, one of the essential features of the invention of claim 23 is that the order terminal is associated with a *business entity* and the digital storage device is associated with a *service provider*. Each of the *business entities* has a predefined business relationship with each of the *service providers*, which relationships are ranked in an order of decreasing closeness, from a "domestic" relationship to a "hostile" relationship, and are stored in a directory (service manager) connected to the network. Because each of the *business entities* has a predefined business relationship with each of the *service providers*, a directory containing, for example, complete information for four service providers and complete information for four business entities necessarily requires that sixteen relationship rankings be contained therein. This ranked relationship database is concisely demonstrated in the table of FIG. 5 (a database) and described in various places in the present patent specification, for example, at page 14, line 25 through page 15, line 21; page 16, lines 1-11; and at page 29, line 20 through page 30, line 8.

A user who has coupled a digital storage device to an order terminal will then

be presented with an order screen on a display of the order terminal, showing products or services from at least two service providers, that is based upon the business relationship between the business entity, that is associated with the order terminal that the user is using, and the service provider, that is associated with the digital storage device that the user coupled to the order terminal. This relationship information is obtained after the service provider code is read from the storage device and sent to the service manager which consults the relationship directory and returns the relationship rankings to the order terminal. The service provider that has a higher ranked business relationship with the business entity will have its products or services listed first on the order screen. These features are described at least at page 18, line 13, through page 21, line 15, describing FIG. 4; and page 30, line 22 through page 31, line 24.

Grounds of Rejection to be Reviewed on Appeal

The following issues are presented for review by the Board of Patent Appeals and Interferences:

1. Whether claims 23, 25-27, and 29 are obvious under 35 U.S.C. 103(a) over Reifel et al., U.S. Patent No. 7,013,288 ("Reifel") in view of Simons, U.S. Patent Application Publication No. US 2003/0014331 ("Simons").

2. Whether claim 28 is obvious under 35 U.S.C. 103(a) over Reifel and Simons in view of Vittal et al, U.S. Patent No. 6,907,401 ("Vittal").

3. Whether claim 23 is indefinite under 35 U.S.C. 112, second paragraph.

Arguments

ISSUE No. 1 Reifel in view of Simons does not render obvious the inventions as set forth in claims 23, 25-27, and 29.

With respect to the second claim element of claim 23, which states:

> providing access for a user to a network server via the network service, the user accessing the network server, by using an order terminal connected to the network, for ordering products, said order terminal associated with one of a plurality of business entities;

the Examiner argues, at page 2 of the Final Office Action, that Reifel's description of

a consumer visiting a print house web site (col. 5, lns. 16-19) causes the terminal to become "associated" with the print house (the "business entity"). This is an incorrect and unreasonable interpretation of the second element of claim 23 for several reasons.

First, the present patent application discusses several times the steps of a user accessing a web site (e.g. service manager 12) with respect to a user operating an order terminal to solicit products and services over a network from service providers. Not even once does the present patent application recognize that such a network access establishes the claimed "association" between an order terminal and a business entity. In fact, a close inspection of FIG. 3 of the present patent application reveals that an order terminal is associated with a business entity, as defined in the present patent application, independently of accessing a network web site. As is clearly illustrated in FIG. 3, order terminals 81, 83, etc., are already associated with business entities A, B, C . . ., before they establish accesses over network 14. Hence, web site accesses do not establish the claimed "association" as the Examiner argues.

Second, the second element of claim 23 itself states, in part, " . . . the user accessing the network server, by using an order terminal connected to the network . . . " Therefore, according to the Examiner's logic, the claimed order terminal must be "associated" with the network server (because it accesses the network server), not the business entity. However, this logic contravenes the claim language itself because the claim recites that an order terminal is associated with a business entity even though the order terminal accesses a network server 12, which server is not directly related to a business entity.

Moreover, the present patent application does not describe the order terminal as accessing a business entity's web site, contrary to the Examiner's assertion, because it only accesses the service manager server 12 which stores information about service providers. The service manager server 12 is nowhere defined as a business entity in the present patent application, nor has the Examiner asserted that it is. Thus, the Examiner's argument falls apart because he neither relies upon the claimed access to the network server to support his argument nor does he recognize that the order terminal does not access a business entity's web site according to the patent application specification.

Third, the Examiner has incorrectly characterized paragraph [0008] of the present Patent Application Publication (corresponding to page 3, lines 12-23) which

he relies upon to interpret the second element of claim 23. The Examiner argues, at page 2 of the Final Office Action, that this paragraph describes a user's home PC accessing a business entity's web site.

The paragraph in question states:

> The present invention encourages photo service providers to establish various types of business relationships with business entities (such as retail store owners and device or software suppliers) who control various types of order terminals, (such as photo kiosks, portable digital imaging devices, or home PCs running application software). These business relationships are provided in a directory. The directory enables the order terminals controlled by different business entities (e.g. different retailers) to access a number of different photo service providers which have established a cooperative business relationship with the business entity, while blocking access to photo service providers that have a hostile business relationship. As a result, a customer has more choices of service providers, and can choose from a wide range of photo products offered by numerous service providers.

Hence, the present patent application clearly states that order terminals access *service providers*, not business entities. Moreover, the "association" between the order terminal and the business entity is described in this paragraph as "business entities (such as retail store owners and device or software suppliers) who control various types of order terminals" [emphasis added]. Thus, this paragraph supports Applicants position that an "association" is established between an order terminal and a *business entity* if the *business entity* controls the order terminal. Such an order terminal is used to access *service provider* information. This clear and unambiguous description contravenes the Examiner's argument that the present patent application describes that accesses to a *business entity* using an order terminal establishes an association between the order terminal and the *business entity*.

With respect to the last phrase of the third claim element, and also the fourth claim element of claim 23, taken together, which state:

. . . the plurality of service providers each having a predefined
business relationship with each of said plurality of business entities;

maintaining a relationship directory indicating a ranking of the
predefined business relationships in a database coupled to the
communication network;

the Examiner cites portions of Reifel wherein Reifel describes a consumer setting up a
user profile wherein one of the entries in the profile includes a preferred print house
(col. 12, ln. 6) and where a contract between the consumer and the camera provider
restricts permissible print houses (col. 5, lines 28-35).

The citations by the Examiner fail to meet the language of the third and fourth
elements of claim 23. First, the Examiner has failed to point out a directory or
database where relationships between each of a plurality business entities and each of
a plurality of service providers are stored. The Examiner has only pointed out that
Reifel teaches (1) that a consumer preferred print house is stored in a consumer
profile and (2) that a contract between the consumer and the camera provider restricts
permissible print houses. These permissible print houses are not ranked nor are
excluded print houses listed (assuming that they exist, which Reifel does not address),
the permissible print houses are merely identified as a group, i.e., ". . . restricted to
those listed by the camera provider and defined within the contract . . ." (col. 5, lns
31-33). These citations by the Examiner do not show a database that contains a
ranking of relationships between each of the plural business entities and each of the
plural service providers, as is clearly and unambiguously recited in claim 23 and
clearly depicted in FIG. 5.

The Examiner relies upon Simons to correct the deficiencies of Reifel,
however, Simons also fails in this regard. Simons is directed to an internet search
facility accessed by users who request searches to be performed and whose results are
displayed to the users in a list. The search facility lists its search results in a preferred
order that favors merchants depending on their paid commissions to the search
facility. A careful reading of Simons at paragraphs [0086] - [0088], and Table 1, as
cited by the Examiner, reveals that merchants are ranked based upon their
payments/relationship with the one system server that performs searching. Thus,

Simons shares the same deficiencies evident in Reifel, in that Simons also does not describe a <u>database</u> that contains a <u>ranking</u> of a relationship between <u>each</u> of the <u>plural</u> business entities and <u>each</u> of the <u>plural</u> service providers. Thus, the Examiners rejection of claim 23 fails to be supported with respect to at least a second claim element.

ISSUE No. 2 Reifel and Simons in view of Vittal does not render obvious the invention as set forth in claim 28.

It is respectfully submitted that further consideration of dependent claim 28, rejected under 35 U.S.C. 103(a), upon the citing of Reifel and Simons is moot, inasmuch as these prior arts lack any teaching, disclosure, or suggestion concerning the elements of claim 23 as described in detail above.

Because Reifel and Simons fail to provide grounds for the rejection of claim 23 under 35 U.S.C. 103(a), as presented above, claim 28 is also allowable over Reifel and Simons because it contains the same limitations as claim 23 by dependency.

ISSUE No. 3 Claim 23 is not indefinite under 35 U.S.C. 112, second paragraph.

Claim 23 states, in pertinent part:

"maintaining a relationship directory indicating a ranking of the predefined business relationships in a database coupled to the communication network;"

and

" . . . according to the relationship data in the database."

The Examiner has rejected this claim because the first occurrence of "database" recites "business relationships in a database" while the second occurrence recites "the relationship data in the database" and so the term "the relationship data" is indefinite.

Because the term "database" occurs only twice in claim 23, both occurrences shown in these excerpts, the second reference to "database" is clearly and unambiguously related to its antecedent. In particular, because the term appears no

where else in this claim or in any dependent claims, a simple comparison of the claim terms "relationships in a database" and "relationship data in the database" makes it unambiguously clear that the second occurrence refers to the first occurrence. Hence, this language in claim 23 is not indefinite under 35 U.S.C. 112, second paragraph.

For these reasons, Appellants respectfully request that the Board of Patent Appeals and Interferences reverse the rejection of claim 23 by the Examiner and mandate the allowance of Claims 23.

Summary

In summary, Applicant respectfully submits that the presently appealed claims are patentably distinct over the cited prior art.

Conclusion

For the above reasons, Appellants respectfully request that the Board of Patent Appeals and Interferences reverse the rejection by the Examiner and mandate the allowance of Claims 23, and 25-29.

Respectfully submitted,

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Enclosures

If the Examiner is unable to reach the Applicant(s) Attorney at the telephone number provided, the Examiner is requested to communicate with Eastman Kodak Company Patent Operations at (585) 477-4656.

23. A computer implemented method comprising:

providing a network service on a network;

providing access for a user to a network server via the network service, the

user accessing the network server, by using an order terminal connected to the network, for

ordering products, said order terminal associated with one of a plurality of business entities;

in response to the user coupling a portable digital storage device to the

network connected order terminal, electronically reading the portable digital storage device,

the portable digital storage device associated with one of a plurality of service providers and

having an image stored thereon, said one of the plurality of service providers identified by

electronically reading a code stored on the portable digital storage device, the plurality of

service providers each having a predefined business relationship with each of said plurality of

business entities;

maintaining a relationship directory indicating a ranking of the predefined

business relationships in a database coupled to the communication network; and

displaying to the user an order screen on said order terminal in response to

reading the code stored on the portable digital storage device, the order screen including

primary purchasing information provided by at least two of said plurality of business entities

from which the user can order a product and/or service related to the image stored on the

portable digital storage device, the primary purchasing information being modified in

response to a ranking of a predefined business relationship between said one of the plurality

of service providers and said at least two of the plurality of business entities, wherein a

modification of the primary purchasing information includes listing first on the order screen

one of the at least two of the plurality of business entities that has a better ranking than

another one of the at least two of the plurality of business entities, according to the relationship data in the database..

25. The method according to claim 23, further comprising the step of modifying the primary purchasing information to include a lower purchase price if said ranking is better.

26. The method according to claim 23 wherein said order terminal comprises one of the following:

an automated teller machine;

a kiosk;

a personal computer; or

a wireless device.

27. The method according to claim 23 wherein said portable digital storage device comprises one of the following:

optical disc;

magnetic floppy disc;

flash memory device; or

a digital camera.

28. The method according to claim 23, further comprising the step of:

displaying different types of products and/or services on the order screen for the user to select, wherein some of the products and/or services are displayed more

prominently based on said ranking of a predefined business relationship between said one of the plurality of service providers and said one of a plurality of business entities.

29. The method according to claim 23 wherein said one of a plurality of business entities provides one or more of the following:

local printing of digital images;

remote printing of digital images;

on-line storage of digital images;

providing digital storage media containing digital images; and

providing associated goods and/or services with respect to hard copy prints.

34. A system for ordering products over a computer network, comprising:

an order terminal connected to the network, the order terminal capable of reading image data from a portable digital storage device coupled to the order terminal by a user, the storage device having stored thereon an image represented by the image data for which the user can order products and/or services over the network via the order terminal, the order terminal associated with a merchant and the storage device associated with one of a plurality of storage device providers;

a database connected to the network for storing a ranking of business relationships between the merchant and the plurality of storage device providers; and

an order screen connected to the order terminal for presenting merchant and pricing information to the user, the merchant and pricing information related to a product and/or service for the image for which the user can place an order via the order terminal, the merchant and pricing information including at least two merchants that are selected according to their having better ranked business relationships with said one of the plurality of storage

device providers than at least one other merchant that is not included in the merchant and pricing information, according to the database.

37.   The system according to claim 34 wherein the merchant and pricing information includes lower prices for merchants in response to a better ranking of a business relationship between those merchants and the plurality of storage device providers.

38.   The system according to claim 34 wherein the merchant and pricing information is formatted so that merchants having a better ranked business relationship with the plurality of storage device providers are listed first.

39.   The system according to claim 34 wherein said order terminal comprises one of the following:

an automated teller machine;

a catalog kiosk;

a personal computer; or

a wireless device.

40.   The system according to claim 34 wherein said merchant provides one or more of the following:

local printing of digital images;

remote printing of digital images;

on-line storage of digital images;

providing digital storage media containing digital images; and

providing associated goods and/or services with respect to hard copy prints.

41. The system according to claim 34 wherein said portable digital storage device comprises one of the following:

optical disc;

magnetic floppy disc;

flash memory device; or

a digital camera.

45. A program storage device readable by machine, tangibly embodying a program of instructions executable by the machine to perform the method steps of claim 23.

Appendix II - Evidence

None

Appendix III – Related Proceedings

None